



31 MAY 2007

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INTERNATIONAL PAPER COMPANY
6285 TRI-RIDGE BOULEVARD
LOVELAND, OH 45140

In re Application of	:	
NELSON, Lloyd et al.	:	DECISION ON
Application No.: 10/572,994	:	
PCT No.: PCT/US02/12961	:	RENEWED PETITION
Int. Filing Date: 25 April 2002	:	
Priority Date: 27 April 2001	:	UNDER 37 CFR 1.47(a)
Attorney's Docket No.: ARZ-024630-WO	:	
For: Polybasic Acid Esters And Their Use In Fibre	:	
Optic Cables	:	

This is a decision on applicant's "Renewed Petition Under 37 C.F.R. 1.47(a) For Filing When Inventors Refuse To Sign Or Can Not Be Found," filed in the United States Patent and Trademark Office on 15 May 2007 on behalf of the non-signing inventor Nancy Mosby. The petition under 37 CFR 1.47(b) is **GRANTED**.

BACKGROUND

On 25 April 2002, applicants filed international application PCT/US02/12961, claiming a priority date of 27 April 2001. The thirty-month for paying the basic national fee in the United States expired at midnight on 27 October 2003.

Applicants did not enter the U.S. National stage prior to the expiration of the thirty-month deadline. As such, the application became abandoned with respect to the United States at midnight on 27 October 2003.

On 23 March 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee and a petition for revival of the application under 37 CFR 1.137(b).

On 21 April 2006, the Office mailed a decision granting applicants' petition for revival under 37 CFR 1.137(b).

On 10 May 2006, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b), the surcharge for late filing of the oath or declaration and additional claim fees of \$1,410 were required.

On 08 November 2006, applicants filed a response to the Notification of Missing Requirements including, a declaration executed by one of the two inventors, a petition under 37 CFR 1.47(a) requesting acceptance of the declaration on behalf of the non-signing inventor Nancy Mosby and, an authorization to charge Deposit Account No. 09-0525 the required surcharge for late filing of the oath or declaration, the additional claim fees of \$1,410, the petition fee and a four-month extension fee.

On 11 December 2006, applicants filed a request for a five-month extension of time to respond. Based on this submission, Deposit Account No. 09-0525 was charged \$2,160. Because the response filed on 08 November 2006 required only a four-month extension of time, the additional extension fee paid for the fifth month was credited back to Deposit Account No. 09-0525.

On 15 December 2006, the Office mailed "Decision on Petition under 37 CFR 1.47(a)" dismissing applicants' petition without prejudice. Because the submitted evidence did not indicate whether a copy of the application had been sent to non-signing inventor Nancy Mosby, the Decision concluded that the inventor's four-year letter (dated 23 April 2002) refusing to be associated with International Paper (with regard to an ISO VG 400 product) does not support the conclusion that the inventor refuses to execute the declaration in the present application, thereby does not meet the requirements of 37 CFR 1.47(a).

On 15 May 2007, applicants filed a renewed a petition under 37 CFR 1.47(a) requesting acceptance of the declaration on behalf of the non-signing inventor Nancy Mosby, a declaration by Mr. Jimmy Gilbreth and a second letter from non-signing inventor Nancy Mosby.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) a statement of the last known address of the missing inventor, (3) an oath or declaration by each applicant on his or her own behalf and on behalf of the non-signing joint inventor and, (4) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort.

As to items (1) and (2), applicants have submitted the correct petition fee of \$200.00 under 37 CFR 1.17(g) and a statement of the last known address of the non-signing inventor resulting from an Internet search (the search was executed by Internet company US Search.com).

With regard to item (3), applicants have filed a declaration executed by the other cooperating inventor and containing an unsigned signature block for the non-signing inventor. This declaration complies with 37 CFR 1.497(a)-(b) and is accepted. Hence, item (3) is satisfied.

With regard to item (4), the declaration by Mr. Jimmy Gilbreth indicates that on two separate occasions (April 27, 2007 and May 7, 2007) a copy of the application had been sent to non-signing inventor Nancy Mosby. The Federal Express tracking confirmations are sufficient to show that the application papers were mailed to the last known address of non-signing inventor Nancy Mosby. Further, the second letter from non-signing inventor Nancy Mosby to Mr. Jimmy Gilbreth (dated 06 May 2007) clearly shows her refusal to be associated with International Application PCT/US02/12961 and hence, the instant application, which is its U.S. national stage. As such, item (4) is satisfied.

As authorized by applicants, the additional claim fees of \$1,410 will be charged to Deposit Account No. 50-4222.

CONCLUSION

Applicants' renewed petition filed under 37 CFR 1.47(a) is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at her last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.



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For: Polybasic Acid Esters And Their Use In Fibre
Optic Cables

Dear Ms. Mosby:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 118. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

A handwritten signature in cursive script, appearing to read "Leonard Smith".

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A handwritten signature in cursive script, appearing to read "Stefan Staicovici".

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